

BURNS DOANE
 BURNS DOANE SWECKER & MATHIS LLP
 ATTORNEYS AT LAW

ALEXANDRIA, VIRGINIA
 REDWOOD SHORES, CALIFORNIA
 DURHAM, NORTH CAROLINA

REPLY TO:
P.O. Box 1404
Alexandria, Virginia 22313-1404

TELEPHONE: +1.703.836.6620

FACSIMILE: +1.703.836.2021 (Group 3)
 +1.703.836.0028 (Group 4)

DATE: June 14, 2002

RECIPIENT INFORMATION	SENDER INFORMATION
To: Examiner M. Trinh	From: Rosemary Riccard for James A. LaBarre
Voice Tel. No.: 703 305 2887	Voice Tel. No.: 703 836 6620
Fax Tel. No.: 703 308 7058	Sent By: Rosemary
Your Ref.: USSN 09/545,288	Our Ref.: 032326-057
	Total Pages (Incl. Cover Page): Five (5)

RE: U.S. Patent Application Serial No. 09/545,288 for "Method for Making Smart Cards Capable of Operating With and Without Contact"; Inventor: Stephane AYALA et al

MESSAGE:

Transmitted herewith please find a copy of a Response which was filed in the U.S. Patent and Trademark Office on November 27, 2001 and a copy of the stamped postcard receipt. Please let us know if we can be of any further assistance in this regard.

FAX RECEIVED

JUN 14 2002

GROUP 3700

NOTE: The information contained in this facsimile message is attorney-client privileged and contains confidential information intended only for the use of the person(s) named above and others expressly authorized to receive it. If you are not the intended recipient, you are hereby notified that any dissemination, distribution or copying of this message is prohibited and you are asked to notify us immediately by telephone and to return this message to us by mail without copying it.

Any questions regarding compatibility should be directed to our Office Services Department at +1.703.836.6620.

late no left.

Attorney's Docket No. 04/032326-052 Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Stephane A YALA et al.

Application No.: 09/545,288

Filed: April 7, 2000

For: METHOD FOR MAKING SMART
CARDS CAPABLE OF OPERATING
WITH AND WITHOUT CONTACT

) Group Art Unit: 3729

) Examiner: M. Trinh

FAX RECEIVED

RESPONSE

JUN 14 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

GROUP 3700

Sir:

In response to the Office Communication dated October 1, 2001, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, on the grounds that it is incomplete and/or improper.

The basic requirement for a proper restriction between inventions is that the inventions must be independent or distinct as claimed. 35 U.S.C. § 121; MPEP § 803. The initial burden is on the Examiner to meet this requirement. Specifically, MPEP § 816 states:

The particular reasons relied upon by the Examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.

In the present case, the Office Communication does not even set forth a conclusion, let alone any reasons that would support the restriction requirement. Since there has been no effort to show independence or distinctness between claimed inventions, the Office

11-27-01 CRS

Application No. 09/545,288
Attorney's Docket No. 032326-057
Page 2

Communication fails to meet both the standards set forth by the Patent and Trademark Office and the requirements of the statute, and therefore should be withdrawn as improper.

In addition, the MPEP sets forth a second criterion for a proper restriction requirement, namely that there must be a serious burden on the Examiner. For purposes of this criterion, the Manual states that a *prima facie* case may be made "if the Examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search..." Again, the Office Communication contains no such showing, and therefore fails to meet the second criterion for a proper restriction requirement. For this additional reason, therefore, the requirement should be withdrawn.

Although the restriction requirement is being traversed for the reasons set forth above, in order that this response be considered to be complete, the following provisional elections are being made:

GROUP I:

Applicants provisionally elect the species of Figures 1 and 3. The claims readable upon this species include claims 1, 2 and 4-30, with claims 1, 4-23 and 25-30 being generic to both species of this group.

GROUP II:

Applicants provisionally elect the species of Figures 5A-5C. The claims readable upon this species include claims 1-4, 6-24, 27 and 29, with claims 1-3, 6-23, 27 and 29 being generic to both of the species in this group.

Application No. 09/545,288
Attorney's Docket No. 032326-057
Page 3

GROUP III:

Applicants provisionally elect Species 3A. The claims readable upon this species include claims 1-16 and 19-30, with claims 1-14 and 21-30 being generic to both species of this group.

GROUP IV:

Applicants provisionally elect Species 4D. The claims readable upon this species include claims 1-13, 23-25 and 30, with claims 1-13, 24 and 25 being generic to more than one of the species in this group.

Reconsideration and withdrawal of the restriction requirement is respectfully requested, on the grounds that it does not meet either of the two established criteria for insisting upon restriction. In the event that the requirement is repeated, or a new one is instituted, it is respectfully requested that the Examiner comply with the standards set forth in the MPEP, and explain the reasons for requiring the restriction.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: James A. LaBarre
James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: November 27, 2001

RECEIVED

JUN 18 2002

TECHNOLOGY CENTER R3700

TOTAL P.02

Filing Date: April 7, 2000

Appln. No.: 09/545,288

Inventor: Stephanie AYALA et al

The following was received in the U.S. Patent and Trademark Office on the date stamped hereon:

Response	
<input checked="" type="checkbox"/> Preliminary Amendment	<input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Certificate Under 37 C.F.R. § 3.75(b)
<input type="checkbox"/> Reply Transmittal Letter	<input type="checkbox"/> Transmittal Letter for Missing Parts of Application
<input type="checkbox"/> Petition for _____ Month Extension of Time	<input type="checkbox"/> Executed Declaration/Power of Attorney
<input type="checkbox"/> Submission of Formal Drawings w/ <u>1</u> sheet(s) of drawings (Figs.)	<input type="checkbox"/> Assignment/Assignment Recordation Form Cover Sheet (PTO-1595)
<input type="checkbox"/> Request for Approval of Drawing Changes w/ <u>1</u> sheet(s) of red ink drawings	<input type="checkbox"/> Claim for Convention Priority w/ <u>1</u> certified copy(s) <input type="checkbox"/> Information Disclosure Statement w/ <u>1</u> document(s) <input type="checkbox"/> Information Disclosure Citation (PTO-1449)
<input type="checkbox"/> Notice of Appeal	<input type="checkbox"/> Information Disclosure Statement Transmittal Letter
<input type="checkbox"/> Brief for Appellant	<input type="checkbox"/> Request for Continued Notice of Recordation of Assignment w/copy of Notice
<input type="checkbox"/> Request for Oral Hearing	<input type="checkbox"/> Request for Continued Examination
<input type="checkbox"/> Reply Brief	<input type="checkbox"/> Response to Restriction Requirement or Election of Species

4/2

TOTAL P. 04